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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Docket No. 402200)

In re the Application of:) **Customer No. 27717**
William R. Wells)
Serial No.: 09/491,899) **Art Unit: 2165**
Filed: January 27, 2000) **Examiner: Mahmoudi**
For: GAMING TERMINAL AND SYSTEM)
WITH BIOMETRIC IDENTIFICATION)

TO: MAIL STOP: Appeal Brief-Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Dear Sir:

This is the Appeal Brief on the Appeal filed April 30, 2007.

A check for the Appeal Brief filing fee of \$500 is enclosed. Please charge
Deposit Account No. 19-1351 of Seyfarth Shaw for any added fees that may be
required.

I. REAL PARTY IN INTEREST

The real party in interest is IGT, the assignee of this application.

II. RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings
known to Appellant, the Appellant's legal representative, or the assignee, which may be
related to, directly affect, or be directly affected by or have a bearing on the Board's
decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-3 are rejected, and comprise claims on appeal.

Claim 4 is canceled.

Claims 5-6 are rejected, and comprise claims on appeal.

Claim 7 is canceled.

Claims 8-10 are rejected, and comprise claims on appeal.

Claim 11 is canceled.

Claims 12 and 13 are rejected, and comprise claims on appeal.

Claims 14-23 are canceled.

Claims 24-29 are rejected, and comprise claims on appeal.

Claim 30 is canceled.

IV. STATUS OF AMENDMENTS

One amendment has been filed subsequent to the final rejection of January 11, 2007, for the purpose of correction of clerical errors in the Listing of Claims noted by the examiner, as indicated on page 3 of the Office Action of January 11, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 calls for a gaming apparatus to be played by a player. The gaming apparatus includes a gaming terminal 122 that is configured for playing at least a first game. A portable biometric smart card 118 is carried by the player and stores biometric data for the player. The smart card 118 also stores financial account information for the player. (Spec. p. 5 line 22 - p. 6 line 8).

A reader 124, for receiving the biometric data stored on the smart card, is coupled to the gaming terminal. A biometric measurement device 126, such as a finger or thumbprint scan device, is also provided. A comparator is used for comparing the

biometric data measured through device 126 to the biometric data stored on the smart card 118. If there is a match, an authorization is outputted, allowing the player to access his or her account and/or use a cash balance on the smart card to play the gaming apparatus. (Spec. p. 6 line 20 - p. 7 line 12).

The present invention solves an important problem in the gaming device industry. In a typical biometric system, reference biometric data for known individuals is stored in a central computer or other central data repository. This is detrimental in the gaming device industry, where many players are reluctant to use a system which requires personal identification such as fingerprint, retinal scan, iris scan, or other biometric information to be stored in a central location, effectively out of the player's possession and control. Applicant has solved this problem with the present invention, using a portable biometric smart card which is carried by the player and which stores the biometric data for the player.

Thus, the player's biometric data does not need to be stored in a database associated with gaming machine 122, where unauthorized access and theft of the data might be an issue. Instead, the biometric data is carried on card 118, so that it may be only transiently entered into the memory of machine 122 and not stored, and it may be compared with the user's actual biometric data as collected through scanner 126.

At the same time, pertinent financial account information for the player may be stored on the same card, such as an account balance, so that the player is free to move between various games and the like without the need to provide any additional authentication, above and beyond presentation of the card and presentation of a finger or the like for biometric scanning at each gaming terminal.

Independent claims 8 and 24 are method claims incorporating similar concepts. In addition, however, independent claims 8 and 24 call for the step of storing personal preference data for the player in the smart card. This step is discussed in the specification, page 6 lines 5-7 wherein the specification refers to preference information "such as indications of types of games, drinks, entertainment and the like preferred, food, smoking/non-smoking preferences, preferred machine denominations and the like."

Still further, claim 24 includes the steps of reading from the smart card a current account balance for an account established for the player, and debiting an amount from the current account balance on the smart card as a fee for playing the game, and establishing a new current account balance on the smart card.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether the specification amendment of 16 April 2004 is validly objected to under 35 U.S.C. 132(a) because it allegedly introduces "new matter" into the disclosure.
2. Whether dependent claims 2, 9 and 25 should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.
3. Whether claims 1, 6, 8, 12-13, 24, 26 and 28-29 are unpatentable over Orus et al. U.S. Publication 2004/0035926 A1 in view of Soltesz et al. U.S. Publication 2001/0011680 A1.
4. Whether claims 2-3, 5, 9-10 and 27 are unpatentable over Orus et al. in view of Soltesz et al., further in view of Thompson U.S. Patent No. 5,865,470.
5. Whether claim 25 is unpatentable over Orus et al. in view of Soltesz et al., further in view of Nakata et al. U.S. Patent No. 5,736,727.

VII. ARGUMENT

1. The Objection to the Specification Amendment.

The Examiner objects to added material to the specification inserted on page 2 of the specification amendment of 16 April 2004. The amendment reads: "These cards may be of conventional dimensions having a thickness less than about one quarter inch, or less than 0.05 inch".

The original specification, p. 5 lines 22-23, points out that the smart card has a profile about the size of a typical credit card.

As argued on page 7 of the amendment of October 30, 2006, originally filed claim 16 of this application unambiguously calls for a card "having a thickness of less than about ¼ inch."

Originally filed claims 2 and 9 of this application call for a card "... having a thickness less than about 0.05 inches."

It is believed to be unnecessary to advise the Board about the rules of new matter in a patent specification. It has been repeatedly held that the disclosure of originally filed claims is part of the original disclosure of a patent application, so that the disclosure of originally filed claims may be placed by amendment into the specification.

Reversal of the Examiner's objection to the specification is thus requested.

2. The Rejection of Claims 2, 9 and 25 under 35 U.S.C. §112, 1st (Claim 30 being Cancelled)

Claims 2, 9 and 25 are rejected under 35 U.S.C. §112, as failing to comply with the written description requirement. As the Examiner states: "The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey the one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

On page 5 of the January 11, 2007 final rejection, the Examiner argues "nowhere throughout the originally filed specification, does any reference exists where the 'thickness' of the card measured in inches or fraction of inches. In fact, this limitation was added to the specification in the amendment filed on 16 April 2004, and therefore constitutes 'new matter'."

As stated in the section above, originally filed claim 16 calls for a card having a thickness of less than about 1/4 inch. Originally filed claims 2, 5 and 9 of this application call for a card having a thickness of less than about "0.05 inches".

Accordingly, it is believed to be elementary that this application includes those disclosures as part of its overall disclosure, thus supporting claims 2, 9, and 25.

3. Claims 1, 6, 8, 12-13, 24, 26 and 28-29 are not Unpatentable Over Orus et al. U.S. Publication No. 2004/0035926 A1 In View of Soltesz et al. U.S. Publication No. 2001/0011680 A1

a. Claims 1 and 6

Orus et al. discloses a method for monitoring the transfer of value units in a chip card gambling system. The card is carried by the gambler, and cash can be transferred between the card and a plurality of gambling machines. As described in paragraphs 0063 and 0091, numerical card identification numbers and balance values stored in the card are compared with a database to certify the data exchanged and to check the integrity of the system.

As stated in paragraph 0092, "...a security module calculates an authentication certificate from secret data stored in the memory of the module and the monitoring means check that the authentication certificate calculated by the security module corresponds to the authentication certificate calculated by the gambling card or by another security module."

Thus, security in the card system of Orus et al. is an entirely numerical system, as shown in detail in Fig. 2, and the related text of the specification.

As the examiner acknowledges, Orus et al. does not disclose a biometric smart card that stores biometric data for the player, or a reader which receives the biometric data stored on the smart card; or a biometric measurement device for measuring biometric data of a user to provide measured biometric data, or a comparator for comparing the measured biometric data to the biometric data stored on the smart card, or the step of outputting an authorization allowing the player to access his or her account if there is a match. None of these elements of the claims are disclosed or taught.

Turning to Soltesz et al., a self-service kiosk is described which is used, as described in its paragraph 0003, as an Automated Teller Machine, or for other types of vending machines, or for Internet or telephone system access. However, there is no teaching in Soltesz of the use of its system with gaming machines. Rather, it is used only for machines where an exact, expected service or product is provided to the user. In the functions described in paragraph 0003, the user of a kiosk knows what the outcome will be. He expects to receive a precise amount of cash, an airline ticket, a telephone call or the like, contrary to the present invention. There would be quite a fuss if he failed to receive it. There is no suggestion of using the Soltesz et al. system with gaming machines where the outcome may be uncontrolled: i.e. winning, or losing so that nothing is provided to the player, or a variable award. Thus, unlike the functions described in paragraph 0003 of Soltesz et al., the player in the present invention does not control the outcome.

In the last paragraph of page 8 of the latest Office Action, the examiner states that it would be obvious to modify Orus et al. by the teaching of Soltesz, because the elements of Soltesz "...would provide both convenience and security for the player to use his smart card to play different games at different gaming machines (e.g., in a casino) using the same card and the same account cash/token balance on the card. This enables the player to walk around in the casino cash-free without risk using his cash or having to carry lots of coins around. Storing users of biometric data (e.g., fingerprint) on the user's card would prevent unauthorized use of the card should the card be stolen or lost and recovered by another player."

However, the above is the invention of applicant, and not the invention of Soltesz et al. or Orus et al. Soltesz et al. makes no mention of use of his system in the gaming apparatus area. From the perspective of Orus et al., the method used therein is already "secured" (see the title of the patent). Those skilled in the art, having Orus et al. before them, are presented with a numerical security system for protection. It would not have been obvious to seek an additional source of security protection, completely different from anything suggested in Orus et al., except as a result of hindsight based on Appellant's own disclosure.

There is no hint in either of the two cited references that there would be a desirability to combine the two systems in a manner not specified by either Orus et al. or Soltesz et al., to come up with the system and method claimed in the present application.

Furthermore, note that Orus et al. in paragraph 0018 calls for a central processing unit that "...has a database that in parallel stores the data representing

gambling operations carried out, particularly card identification data and data representing the balances of value units debited and/or credited...”

This parallel storing of card identification data teaches away from the concept of Soltesz et al. in which the biometric card identification data is not stored in the kiosk, but rather is only stored on the card. Thus, those skilled in the art would be led away from combining the references.

Thus it is submitted that the claims in question are patentable over Orus et al. in view of Soltesz et al.

b. Claims 8, 12-13, 24, 26 and 28-29

Claims 8, 12-13, 24, 26 and 28-29 call for a gaming method for a gaming apparatus having the claimed subject matter of claim 1 discussed above, and are patentable for the same reason that claim 1 is patentable. In addition, claims 8 and 24 include the step of storing personal preference data for the player in the smart card. As stated on page 5 of the specification, lines 27-29, the preference information may be “indications of types of games, drinks, entertainment and the like preferred, food, smoking/non-smoking preferences, preferred machine denominations and the like.”

In accordance with Appellant’s invention, the player’s personal preference data, which is stored on the smart card, need not be stored in a database associated with a gaming machine, where unauthorized access and theft of this personal data might be an issue. Neither the Orus et al. patent or the Soltesz et al. patent disclose this limitation. The examiner contends that this limitation is found in paragraphs 12 and 18 of Orus et al., indicating that “personal preference data” is read on “card balance” and read on “information on the gambler.” This is clearly erroneous because the mere reference to the terms “card balance” and “information on the gambler” in Orus et al. is

not a disclosure of the step of storing personal preference data for the player in the smart card. The “card balance” has nothing to do with a player’s “personal preference data” and “information on the gambler” relates to the identification of the gambler, not the player’s “personal preference data” as claimed.

4. Claims 2-3, 5, 9-10 and 27 are Patentable over Orus et al. in view of Soltesz et al., Further in View of Thompson U.S. Patent No. 5,865,470

Claims 2-3, 5, 9-10 and 27 are claims that are dependent upon claims that are submitted to be allowable in view of the arguments above. As such they also are patentable because of such dependency.

5. Claim 25 is Patentable over Orus et al. in view of Soltesz et al. Further in View of Nakata et al. U.S. Patent No. 5,736,727

Claim 25 shares in the limitations of claim 24 which is submitted to be patentable on the basis of the arguments above, and thus also is patentable.

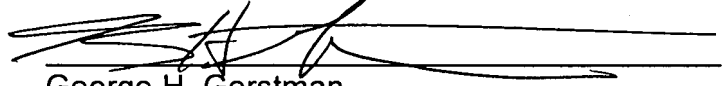
VIII. CONCLUSION

Appellant’s invention solves an important problem in the gaming device industry, enabling a player’s access to a gaming machine to be authorized based on the match of the player’s biometric data as measured against biometric data stored on a smart card, without the need to store the player’s biometric data in a database associated with the gaming machine. This is not disclosed by the prior art references, whether taken alone or in combination with each other, and Appellant’s claims are patentable.

In view of the foregoing, the Board is urged to reverse the examiner’s rejections.

Respectfully submitted,

SEYFARTH SHAW LLP

A handwritten signature in dark ink, appearing to read "G. Gerstman", is written over a horizontal line.

George H. Gerstman
Registration No. 22,419
Attorney for Applicant

SEYFARTH SHAW LLP
131 S. Dearborn Street, Suite 2400
Chicago, Illinois 60603
(312) 460-5567

CLAIMS APPENDIX

1. A gaming apparatus to be played by a player, comprising:
 - a portable biometric smart card carried by the player storing biometric data for the player and also storing financial account information for the player; said biometric card carried by the player separate from the gaming apparatus;
 - a gaming terminal, configured for playing at least a first game;
 - a reader, coupled to the gaming terminal which receives said biometric data stored on said smart card;
 - a biometric measurement device for measuring biometric data of a user to provide measured biometric data; and
 - a comparator for comparing said measured biometric data to the biometric data stored on said smart card and if there is a match, outputting an authorization allowing the player to access his or her account and/or use a cash balance on the smart card to play the gaming apparatus.
2. Apparatus as claimed in Claim 1, wherein:
 - said smart card has a thickness of less than about 0.05 inch.
3. Apparatus as claimed in Claim 2, wherein:
 - said smart card includes a microprocessor.
5. Apparatus as claimed in Claim 2, wherein:
 - said smart card further stores a current account balance for an account established for said first user.
6. Apparatus as claimed in Claim 1, wherein:
 - said biometric measurement device is selected from among:
 - a thumb print scanner;

a fingerprint scanner;
a retina scanner;
an iris scanner;
an ear scanner;
a voice data sensor;
a facial scanner; or
an infrared scanner.

8. A gaming method for a gaming apparatus to be played by a player comprising:

storing first biometric data for a player in a portable biometric smart card carried by the player, which smart card is carried by the player separate from the gaming apparatus, storing financial account information for the player in said smart card, and also storing personal preference data for said player in said smart card;

providing a gaming terminal;

coupling a reader to said gaming terminal, configured for playing at least a first game, wherein said reader receives said first biometric data stored on said smart card;

measuring biometric data of said player to provide measured biometric data; and

comparing said measured biometric data to said biometric data stored on said smart card; and if there is a match, outputting an authorization allowing the player to access his or her account and/or use a cash balance on the smart card to play the gaming device.

9. A method as claimed in Claim 8, wherein:

said step of storing includes storing in a smart card having a thickness less than about 0.05 inches.

10. A method as claimed in Claim 9, wherein:

said card includes a microprocessor.

12. A method as claimed in Claim 8, further comprising:

storing, on said portable biometric smart card, a current account balance for an account established for said first user.

13. A method as claimed in Claim 8, wherein:

said step of measuring includes a step selected from among:

scanning a thumb print;

scanning a fingerprint;

scanning a retina;

scanning an iris;

scanning an ear;

sensing voice data; or

scanning a face.

24. A gaming method for a gaming apparatus to be played by a player, comprising:

storing first biometric data for a player in a portable biometric smart card carried by the player, which smart card is carried by the player separate from the gaming apparatus wherein said smart card also stores personal preference data for said player;

providing a gaming terminal;

coupling a reader to said gaming terminal, configured for playing at least a first game, and reading said biometric data stored on said card;

measuring biometric data of a player to provide measured biometric data;

comparing said measured biometric data to said biometric data stored on said smart card, and if there is a match, outputting an authorization allowing the player to access his or her account and/or use an account balance on the smart card to play the gaming apparatus;

reading from the same smart card a current account balance for an account established for said player; and

debiting an amount from said current account balance on said smart card as a fee for playing said game, and establishing a new current account balance on said smart card.

25. The method of claim 24 in which said card has a thickness of less than about one quarter inch.

26. The method as claimed in claim 24 wherein:

said step of measuring includes a step selected from among:

scanning a thumb print;

scanning a fingerprint;

scanning a retina;

scanning an iris;

scanning an ear;

sensing voice data; or

scanning a face.

27. Apparatus as claimed in claim 5 in which the player's winnings from play of said gaming apparatus are credited to a current account balance.

28. The gaming method of claim 8 in which the player's winnings from said gaming method are credited to a current account balance of said smart card.

29. Apparatus as claimed in claim 1 in which said smart card includes a microprocessor and in which said smart card further stores a current account balance for an account established by said first user, in which the user's winnings from play of said gaming apparatus are credited to said current account balance.

EVIDENCE APPENDIX

(None)

RELATED PROCEEDINGS APPENDIX

(None)



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Registered Attorney for Applicant

Date: June 26, 2007